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EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,378

Applicant(s)

BARNETT ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 76-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/7/04, 4/19/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 76-112 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/04 has been entered.

Response to Amendment

3. The Amendment filed on 4/7/04 is insufficient to overcome the prior rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claim 76-112 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 63-74 of copending Application No. 09/321,597. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 76-81, 83-89 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-8 of U.S. Patent No. 6,321,208. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 82, 91 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 82 discloses, "...coupon is provided to the user via an electronic mail message".

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However, the Applicant's specification does not disclose utilizing an electronic mail message to provide to the user the coupon.

Claim 91 discloses, "wherein downloading the incentive data management software module comprises downloading the unique identifier".

However, the Applicant's specification does not support this combination of features.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 76-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hohorn (5,227,874) in view of Saigh (5,734,823).

Claim 76, 88, 111, 112: Von Kohorn discloses a method for viewing and printing at a remote terminal user-specific incentives, the method comprising:
storing at a network-accessible location incentive information pertaining to a group of available incentives (col 74, lines 33-40; col 16, lines 30-40; col 19, lines 20-39; Fig. 29, item 904; col 94, lines 35-41; col 95, lines 5-10; col 45, line 41-44);
storing user profile information and user usage history information for one or more users (col 3, lines 33-col 4, line 2; col 1, line 55-col 2, line 48; col 46, lines 41-46; col 113, lines 20-22);

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receiving at the network-accessible location, from a user of a remote terminal, a request for access to the stored incentive information (col 2, line 65-col 3, line 2);

determining at the network-accessible location if the user is a registered user, and if the user is not registered (col 3, line 56-col 3, line 66; col 94, line 56-col 94, line 70; col 97, line 64-col 98, line 5; col 100, lines 42-50; col 103, line 65-col 104, line 3,);

i) transmitting a prompt to the user's remote terminal to electronically complete a user profile (col 46, lines 41-46; col 113, lines 20-22);

ii) receiving and storing the user profile (col 3, lines 33-col 4, line 2; col 1, line 55-col 2, line 48; col 46, lines 41-46; col 113, lines 20-22); and

iii) downloading to the user's remote terminal an incentive data management software module for managing the printing of incentives (col 2, lines 55-63; col 14, lines 20-25; col 10, lines 40-45; col 13, lines 60-66; col 74, lines 33-40; col 16, lines 35-40; Fig. 30), wherein a printed incentive includes unique user identification information (col 10, lines 40-45; col 137, lines 25-30);

if the user is registered, the user viewing a subset of incentives from the group of available incentives, the subset of incentives being based on user-specific information, which comprises at least one of the user profile information and the user usage history information (col 2, line 6-37; col 3, lines 55-col 4, line 2; col 106, lines 1-10; col 2, lines 49-56);

the user selecting one or more incentives from the subset of incentives for printing, each of the one or more incentives comprising various fields, including a redemption amount field and at least one other field, the redemption amount field comprising data indicative of a discount provided by the incentive, the at least one other field being determined in accordance with user-

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specific information associated with the requesting user (col 37, line 10-35; col 3, lines 45-50; col 22, lines 1-15);

printing at the remote terminal, under control of the incentive data management software module, one or more of the user-selected incentives (col 37, line 10-35);

subsequent to a user redeeming one or more of the printed incentives, providing at least incentive redemption data to at least one incentive distributor or incentive issuer to enable the at least one incentive distributor or incentive issuer to use at least the incentive redemption data for market analysis to create at least one subsequent target incentive targeted based on the criteria; and making the at least one subsequent incentive available to the user if the user satisfies the targeting criteria (col 3, line 33-col 4, line 2; col 1, lines 25-42; col 1, line 59-col 2, line 20).

Von Kohorn further discloses that the method can utilize a variety of networks (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15).

Von Kohorn further discloses the utilization of networks for disseminating information (Fig. 7; col 38, line 60-col 39, line 5), that coupons can be transmitted to users (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11; col 47, line 40-col 48, line 2; col 2, lines 45-52), and that coupons can be printed (col 10, lines 15-21).

Von Kohorn does not explicitly disclose that the communication channel can be the Internet.

However, Saigh discloses the utilization of the Internet for the dissemination of a variety of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users (col 14, lines 60-65; col 8, lines 3-6) and that the coupons can be printed (col 8, lines 59-61).

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Saigh further discloses that the service system is associated with an Internet web site (col 14, lines 15-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's utilization of the Internet to Von Kohorn transmitting coupons. One would have been motivated to do this because the Internet is a readily available network for transmitting information.

Von Kohorn further discloses downloading or transmitting instructional signals and programming routines (col 2, lines 55-60; col 109, lines 10-16; col 14, lines 20-25; col 20, lines 57-65; col 26, lines 45-52; col 6, line 56-col 7, line 27).

Von Kohorn further discloses that the programming instructions are ordered as a module or in a group (col 5, lines 31-45; col 4, line 21-35; col 41, lines 28-60).

Von Kohorn further discloses that the programmed response unit can print incentives (col 2, lines 52-56; col 39, lines 24-31; col 41, lines 52-60; col 19, lines 29-34; col 20, lines 57-64; col 22, lines 49-55; col 34, line 67-col 35, line 6).

Additionally, Von Kohorn discloses that the user's system is specified as a remote system (Fig. 2; page 20, lines 7-11). Furthermore, the printer's are associated with the user's system (page 16, lines 5-10).

Additionally, Von Kohorn discloses electronically storing a plurality of coupons in a memory associated with the electronic coupon dispensing system (col 76, lines 55-60; Fig. 25; Fig. 26).

Von Kohorn further discloses permitting selection from said plurality of coupons from a coupon menu (col 2, line 65-col 3, line 2; col 81, lines 42-45; Fig. 25; Fig. 26).

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Additionally, Von Kohorn discloses downloading coupon information from a host to a client (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11) where the host is a host system (col 94, lines 32-47) and the client is a client system (Fig. 26).

Von Kohorn further discloses that the consumer can indicate an interest in a product and that incentives can be sent to a consumer in response to the consumer interest (col 47, line 40-col 48, line 2) and that the incentives can be coupons (col 2, lines 45-52).

Von Kohorn further discloses targeting incentives to users based on user history information (col 108, lines 31-65).

Von Kohorn further discloses that the user can select incentives or coupons for printing (col 2, line 65-col 3, line 2; col 101, lines 30-36; col 109, lines 10-27; col 111, lines 44-68).

Von Kohorn further discloses that each printed incentive can be rendered unique by including on the printed incentive user identification information and unique incentive information (col 2, lines 10-29; col 3, lines 31-37; col 3, lines 55-66; col 39, lines 42-46; col 40, lines 10-15; col 86, lines 3-24).

Von Kohorn further discloses storing information at the Internet-accessible service system regarding incentives printed by the printer associated with the remote user system (col 30, lines 41-46; col 3, lines 2-14; col 39, lines 25-32).

Von Kohorn further discloses receiving redemption information regarding one or more printed incentives that have been redeemed; and storing the redemption information at the Internet accessible service system (col 89, lines 35-42; col 101, lines 55-65; col 104, lines 25-34; col 106, lines 38-54; col 10, lines 15-21).

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Von Kohorn further discloses that the redemption information is associated with the remote user system (col 2, lines 20-29), is associated with a user associated with the remote user system (col 1, lines 59-66), is associated with an account associated with the remote user system (col 3, lines 17-22; col 94, lines 1-12; col 94, lines 56-62; col 97, lines 64-70; col 103, line 62-col 104, line 2).

Claim 77: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses storing at an Internet-accessible location incentive information pertaining to a group of available incentives further comprises storing advertising materials provided by one or more incentive issuers or distributors (col 2, lines 40-65).

Claim 78: Von Kohorn and Saigh disclose the method of claim 77, and Von Kohorn further discloses that the advertising materials comprise one or more of graphics, text, recipes, competitions, or inducements (col 2, lines 40-65).

Claim 79: Von Kohorn and Saigh disclose the method of claim 77, and Von Kohorn further discloses enabling a user to view a subset of incentives further comprises the step of enabling the user to view the advertising materials (col 47, line 40-col 48, line 2; col 2, line 65-col 3, line 2; col 81, lines 10-23; col 81, lines 7-40).

Claim 80: Von Kohorn and Saigh disclose the method of claim 76, wherein the user profile received and stored at the Internet accessible location comprises demographic data (col 46, lines 41-46; col 113, lines 20-22).

Claim 81: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that redemption data for multiple users is used by the at least one incentive distributor or incentive issuer for market analysis to compile at least one subsequent incentive

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targeted specifically at the user (col 1, lines 25-43; col 1, lines 59-col 2, line 11; col 3, lines 55-col 4, line 2; col 106, lines 1-10).

Claim 82, 83: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn further discloses that the at least one subsequent incentive is downloaded from the network-accessible location (col 2, line 6-37; col 3, lines 55-col 4, line 2; col 106, lines 1-10; col 2, lines 49-56).

Von Kohorn does not explicitly disclose that the incentives are downloaded from an Internet accessible location.

However, Saigh discloses utilizing the Internet (col 1, lines 38-41; col 5, lines 20-30) and downloading promotional information (col 14, lines 15-31).

Saigh further discloses the utilization of e-mail for incentive related communication (col 14, lines 26-29).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's downloading via the Internet or Saigh's utilization of e-mail to Von Kohorn's downloading incentives. One would have been motivated to do this because the Internet is a readily available network for electronic communication.

Claim 84: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that the at least one subsequent incentive is for a product other than a product covered by the one or more redeemed printed incentives (col 84, lines 11-25; col 106, lines 3-10; col 3, line 37-col 4, line 2).

Claim 85: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that the at least one subsequent incentive is for a same product covered by the

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one or more redeemed printed incentives, but having a different value (col 3, lines 45-50; col 22, lines 1-15).

Claim 86: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn does not explicitly disclose that the at least one subsequent incentive is transmitted to a retailer for electronic redemption.

However, Von Kohorn discloses redeeming incentives at a retailer and mailing incentives for redemption (col 8, lines 47-49), redeeming incentives in a variety of manners including over the phone (col 82, lines 40-45), and the electronic transfer of incentive information to redemption centers (col 40, lines 10-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn electronic transfer of redemption information to Von Kohorn varied manners of redeeming incentives. One would have been motivated to do this so that Von Kohorn's users have an additional and convenient way of redeeming incentives.

Claim 87: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn further discloses that the service system is associated with a service provider (col 10, lines 21-30; col 88, line 55- col 89, line 15).

Von Kohorn does not explicitly disclose an online service.

However, Saigh discloses online service (col 1, lines 38-41; col 5, lines 20-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's online service provider to Von Kohorn service provider. One would have been motivated to do this because an online service provider is analogous to a service provider.

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Claim 89: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that the incentives available to a user are sorted by categories (col 46, line 62- col 47, line 5).

Claim 90-98: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn further discloses downloading to the remote terminal a unique identifier (col 39, lines 44-59).

Von Kohorn further discloses that downloading the incentive data management software module comprises downloading the unique identifier (col 41, lines 44-52; col 109, lines 10-16).

Von Kohorn further discloses that the unique identifier is stored on the remote terminal (col 86, lines 12-24; col 76, lines 55-60).

Von Kohorn further discloses that each printed incentive can be rendered unique by including on the printed incentive user identification information and unique incentive information (col 2, lines 10-29; col 3, lines 31-37; col 3, lines 55-66; col 39, lines 42-46; col 40, lines 10-15; col 86, lines 3-24).

Von Kohorn further discloses that the user identification information is encoded in a user-specific bar code included on the printed incentive (col 10, lines 40-45; col 37, lines 25-30).

Von Kohorn further discloses that each printed incentive is printed with a unique bar code including unique identification information or printed with a unique identification number (col 37, lines 19-32; col 10, lines 40-45).

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Claim 99, 102, 103: Von Kohorn and Saigh disclose the method of claim 76. Von Kohorn further discloses that the profile includes at least the user's demographic information (col 46, lines 41-46; col 113, lines 20-22; col 3, lines 33-37; col 3, lines 42-col 4, line 2).

Von Kohorn further discloses collecting demographic data (col 46, lines 41-46; col 113, lines 20-22).

Von Kohorn further discloses that the demographic data can be collected at a variety of times (col 98, lines 33-45; col 46, lines 41-46; col 113, lines 20-22) in order to better target a user (col 98, lines 33-45, col 113, lines 19-24) and that user profile information can include user preference information (col 98, lines 33-45, col 113, lines 19-24).

Claim 100, 101: Von Kohorn and Saigh disclose the method of claim 99. Von Kohorn further discloses that the incentives available to a user are based on the user data, and wherein the user data includes at least the user's geographic information (col 1, line 63-67; col 20, lines 1-5; col 1, lines 36-42; col 10, lines 21-30).

Von Kohorn does not explicitly disclose that the zip code is part of the user geographic information.

However, Von Kohorn discloses utilizing mailing address information (col 20, lines 1-5), that stations service different geographic regions (col 10, lines 21-30), that households are identified (1, lines 36-42), and identifying different geographic regions such as counties (col 46, lines 41-47), identifying user distance from points of interest (col 113, lines 19-24), and that a wide variety of user information can be utilized for profiling a user (col 113, lines 19-24).

Additionally, zip code is part of standard information for identifying a household and mailing address information includes zip codes.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn's mailing address information with zip code to Von Kohorn's information on a user. One would have been motivated to do this in order to accurately identify user location or region.

Claim 104-107: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn further discloses enabling the user to register an account with the Internet-accessible service system (col 94, lines 1-12; col 94, lines 56-62; col 97, lines 64-70; col 103, line 62-col 104, line 2).

Von Kohorn further discloses determining at the network-accessible location if the user is a registered user, and if the user is not registered (col 3, line 56-col 3, line 66; col 94, line 56-col 94, line 70; col 97, line 64-col 98, line 5; col 100, lines 42-50; col 103, line 65-col 104, line 3);

i) transmitting a prompt to the user's remote terminal to electronically complete a user profile (col 46, lines 41-46; col 113, lines 20-22);

ii) receiving and storing the user profile (col 3, lines 33-col 4, line 2; col 1, line 55-col 2, line 48; col 46, lines 41-46; col 113, lines 20-22).

Von Kohorn further discloses individual, household, and individual and household accounts (col 1, lines 35-43; col 1, lines 61-67; col 3, lines 55-67).

Claim 108-110: Von Kohorn and Saigh disclose the method of claim 76. Von Kohorn further discloses receiving redemption information regarding one or more printed incentives that have been redeemed; and storing the redemption information at the Internet accessible service

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system (col 89, lines 35-42; col 101, lines 55-65; col 104, lines 25-34; col 106, lines 38-54; col 10, lines 15-21).

Von Kohorn further discloses that the redemption information is associated with the remote user system (col 2, lines 20-29; col 102, lines 1-5), is associated with a user associated with the remote user system (col 1, lines 59-66; col 102, lines 1-5), is associated with an account associated with the remote user system (col 3, lines 17-22; col 94, lines 1-12; col 94, lines 56-62; col 97, lines 64-70; col 103, line 62-col 104, line 2).

Response to Arguments

7. Applicant's arguments with respect to claims 76-112 have been considered but are not found persuasive.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

In response to arguments beginning on page 9 of the Applicant's Amendment dated 4/7/04 concerning the 35 USC 112 rejection, the Examiner has carefully reviewed the sections and Figure the Applicant has cited in order to attempt to show support for providing the user a coupon via an electronic mail message as disclosed in claim 82. However, these citations, as well as the rest of the specification, only support utilizing electronic transmittal (such as downloading) for providing a coupon to a user. However, the Applicant's specification does not disclose utilizing an electronic mail message to provide to the user the coupon. Therefore, there is no support for utilizing an electronic mail message to provide to the user the coupon.

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Additionally, new dependent claim 91 has been found to not be supported by the Applicant's specification.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On page 11 of the Amendment dated 4/7/04, Applicant states, "Von Kohorn does not, as recited above, appear to disclose, teach, or suggest *at least* downloading to a user's remote terminal an incentive data management software module for managing the printing of incentives, and printing at the remote terminal, under control of the incentive data management software module, one or more user-selected incentives."

However, Von Kohorn discloses downloading or transmitting instructional signals and programming routines (col 2, lines 55-60; col 109, lines 10-16; col 14, lines 20-25; col 20, lines 57-65; col 26, lines 45-52; col 6, line 56-col 7, line 27).

Von Kohorn further discloses that the programming instructions are ordered as a module or in a group (col 5, lines 31-45; col 4, line 21-35; col 41, lines 28-60).

Von Kohorn further discloses that the programmed response unit can print incentives (col 2, lines 52-56; col 39, lines 24-31; col 41, lines 52-60; col 19, lines 29-34; col 20, lines 57-64; col 22, lines 49-55; col 34, line 67-col 35, line 6).

Additionally, Von Kohorn discloses that the user's system is specified as a remote system (Fig. 2; page 20, lines 7-11). Furthermore, the printer's are associated with the user's system (page 16, lines 5-10).

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Additionally, Von Kohorn discloses electronically storing a plurality of coupons in a memory associated with the electronic coupon dispensing system (col 76, lines 55-60; Fig. 25; Fig. 26).

Von Kohorn further discloses permitting selection from said plurality of coupons from a coupon menu (col 2, line 65-col 3, line 2; col 81, lines 42-45; Fig. 25; Fig. 26).

Additionally, Von Kohorn discloses downloading coupon information from a host to a client (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11) where the host is a host system (col 94, lines 32-47) and the client is a client system (Fig. 26).

Von Kohorn further discloses that the consumer can indicate an interest in a product and that incentives can be sent to a consumer in response to the consumer interest (col 47, line 40-col 48, line 2) and that the incentives can be coupons (col 2, lines 45-52).

Von Kohorn further discloses targeting incentives to users based on user history information (col 108, lines 31-65).

Von Kohorn further discloses that the user can select incentives or coupons for printing (col 2, line 65-col 3, line 2; col 101, lines 30-36; col 109, lines 10-27; col 111, lines 44-68).

Von Kohorn further discloses that each printed incentive can be rendered unique by including on the printed incentive user identification information and unique incentive information (col 2, lines 10-29; col 3, lines 31-37; col 3, lines 55-66; col 39, lines 42-46; col 40, lines 10-15; col 86, lines 3-24).

In response to applicant's argument that Von Kohorn and Saigh are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was

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concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Von Kohorn discloses the utilization of networks for disseminating information (Fig. 7; col 38, line 60-col 39, line 5), that coupons can be transmitted to users (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11; col 47, line 40-col 48, line 2; col 2, lines 45-52), and that coupons can be printed (col 10, lines 15-21).

Saigh discloses the utilization of the Internet for the dissemination of a variety of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users (col 14, lines 60-65; col 8, lines 3-6) and that the coupons can be printed (col 8, lines 59-61).

Conclusion

This is a RCE of applicant's earlier Application No. 09/754,378. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

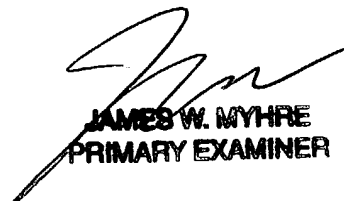
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

6/4/04


JAMES W. WYHRE
PRIMARY EXAMINER